

REMARKS

Claim 13 has been amended to define the method in accordance with the present invention for enabling visual inspection and identification of a formulation and also provides for a positively-claimed step of the claimed invention, to wit, using bottle properties to visually inspect the formulation in the bottle and identify the formulation by the color of the bottle.

The Applicant has elect to choose the preamble and the body of the claim to define the subject matter of the claimed invention. The selection is support by Bicon, Inc., et al. v. The Straumann Co., et al. which affirmed a lower courts holding that the preamble claim may recite the essential limiting elements of the invention which pertains to the invention and that it does not merely state the purpose or attended use of the invention. 78 USPQ 2d, 1267 (US Court of Appeals Federal Circuit 2006). Under the rule expounded in NTP v. RIM, the preamble is “limiting” if it recites essential structure that is imparted to the invention or necessary to give meaning to the claim. 75 USPQ 2s 1763 (Fed. Cir. 2005).

Further, MPEP 2111.01 relied on by the Examiner states that the words of a claim must be given their “plain meaning” unless such meaning is inconsistent with the specification. This certainly is not the case at hand since the claimed language correlates with the specification on page 8 beginning at line 22. *In re Zletz*, 13 USPQ 2d 1320 (Fed. Cir. 1989); Chef America, Inc. v. Lamb-Weston, Inc., 69 USPQ 2d 1857 (Fed. Cir. 2004).

Accordingly, claims are not to be read in a vacuum and limitations therein are to be interpreted in light as specification and giving it their broadest reasonable interpretation. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). Therefore, the Applicant respectfully requests the Examiner to consider the positively claimed step in determination of obviousness under 35 USC 103(a).

The Examiner has heretofore rejected claim 13 under 35 USC 103(a) as being unpatentable over U.S. 5,799,837 to Firestone, et al. in view of U.S. Publication 2001/0048988 to Forte, et al.

The Examiner has stated that Firestone shows that it is known to carry out a method of forming a bottle which includes providing a mixture of polypropylene resin with UV absorbers and forming the heated UV absorbent mixture into a cylindrical squeezable bottle. The Examiner acknowledges that Firestone has not shown a second and third set of resin pellets and also does not show a specific mixing of water to obtain such a mixture. The Examiner relies on MPEP 2144.04(IV)(C) in stating the selection of any order of mixing ingredients is prima facie obvious. In view of the fact that Firestone does not specifically show for a second and third sets of resin pellets or providing dyes stuffs to the pellets, the Examiner looks to Forte for showing that it is normal to carry out the method of making of bottle useful as a pharmaceutical container including providing combinations of polypropylenes.

However, none of the references teach the presently claimed method for enabling visual inspection and identification of a formulation which includes forming at the bottle and using the bottle properties. In view of this lack of teaching, the Applicant respectfully submits that the Examiner has not made a prima facie case of obviousness under 35 USC 103(a) on the basis of the Firestone and Forte references.

In view of the arguments hereinabove set forth and amendment to the claim, it is submitted that the claim in the application define patentable subject matter not anticipated by the art of record and not obvious to one skilled in this field who is aware of the references of record. Reconsideration and allowance are respectfully requested.

Respectfully submitted,
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